UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,520	05/31/2000	Claude M. Leglise	INTL-0391-US (P8805)	1973

7590 08/11/2005	EXAMINER
Timothy N Trop	RETTA, YEHDEGA
Trop Pruner & Hu PC	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/584,520	LEGLISE ET AL.
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8-16,18-27 and 36-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 8-16, 18-27 and 36-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 17

DETAILED ACTION

Response to Amendment

This office action is in response to RCE filed May 23, 2005. Applicant amended claims

1, 3, 11, 21 and 36. Claims 1-5, 8-16, 18-27 and 36-38 are pending in this case.

Applicant's amendment, overcome the rejection of 112, first paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claim 36 recites the limitation "based on another user of <u>said system's on-line activities</u>".

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at the time the invention was made
to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

Claims 1-5, 8-16, 18-27 and 36-38, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Netsurfer as taught by "Netsurfer makes it easy" Broadwatch Magazine; Todd

Judd Erickson January 2000, in view of "ZipLink's Virtual Internet Service Provider (ISP)

Program Provides complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999

(hereinafter ZipLink).

Regarding claim 1, Netsurfer teaches providing signup CD to ISP, with everything on it,

branded by an ISP; providing Internet service through graphical user interface provided by the

service provider (ISP) (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using

branded interface can provide user access to the web, and direct access to the ISP's content

partners (see page 76 col. 2 and 3). Using the SoftCast, the ISP pushes content to a user

computer and makes changes to the computer and pushes software updates, ... and can also fix

problems including errors and software bugs... and update thirdparty software (see 78 and 80).

Netsurfer however does not teach providing Internet services to customer through a service

provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches

providing private-branded Internet connectivity, **which enables e-businesses, affinity groups**

and web-centric organizations, etc. to become Virtual ISPs, which implies that customers

obtaining Internet service through the vendor see a graphical interface from the vendor not from

Ziplink. Ziplink teaches that the service includes custom sign-up, activation and authentication,

billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the

system customers avoid the tremendous investment of building and maintaining a national

network and the cost of staffing a customer care operation center (see page 1). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be

motivated to provide private-branded Internet service to e-business (retail vendors) that enable

them to become Virtual ISPs since outsourcing the connectivity or service and customer care

function enables the customers (vendors) to concentrate on building their business and avoid the

tremendous investment of building and maintaining a national network, as taught by Ziplink (see

page 1). Netsurfer teaches controlling the ability of the customer to add software or hardware.

Netsurfer states "SoftCast is a technology, written by Netsurfer using Internet standards, that

allows the ISP to push content to a user's computer and make changes to that computer"(see

page 78 col. 3 under SOFTCAST). Netsurfer also states, "The ISP can use SoftCast to push

software updates, marketing materials, news or account queries to the subscriber. It can also fix

problems on the subscriber's computer including registry errors or software bugs" (see page 80

col. 1 line 1-6). Further Netsurfer state "Because it is built using industry-standard protocols,

SoftCast can also update any third-party software on the user's machine, such as word

processors, spreadsheets or games" (see page 80 col. 1. lines 28-40). Netsurfer does not teach

providing customized advertising to the client based on preferences received form the client.

Official notice is taken providing customized advertising to said client based on preferences

received form the client is old and well known in the art of marketing. One would be motivated

to provide customized advertising based on user preference in order to develop a one-to-one

relationship with the user, by providing a targeted content. Netsurfer teaches enabling the service

provider to provide control software and hardware added to user computer (see page 78 and 80

Col. 1).

Regarding claim 2, Netsurfer teaches customizing the content provided based on the

customer's identity (see page 78 col. 3 and page 80 col. 1-3)

Regarding claim 3, Netsurfer teaches controlling the initial graphical user interface,

provided by the service provider, displayed after booting of the system (see page 78 col. 1 and

2). Netsurfer teaches, once the customer place the CD in the computer the signup program uses

wizards to guide the user through the account creation and network connection processes (see page 78).

Regarding claim 4, Netsurfer does not teach providing confidential information to service provider instead of retail store. Ziplink teaches the Virtual ISP program offering a full suite of customer card management services including customer sign-up, activation and authentication, which indicate that all the back-end services including authentication being performed by the Virtual ISP (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's sign-up program with Ziplink's Virtual ISP program. One would be motivated to provide confidential information to the Internet service provider instead of the retail vendor since the service provider is the one who is performing the authentication.

Regarding claim 5, Netsurfer teaches providing the customer with a predefined set of selection (see page 80 and fig. 2&3).

Regarding claim 8, Netsurfer teaches receiving the customer preference on customer computer coupled to the service provider over the Internet, forwarding the customer preference to the service provider, customizing the content based on the information (see page 80). 9.

Regarding claim 9, Netsurfer teaches automatically directing the customer to a server associated with retail vendor when the customer wishes to obtain a product or service offered by the retail vendor (see page 78 Col. 2&3). Netsurfer teaches any ISP can have a branded desktop with its own channels and content partners and the ISP-branded interface can provide user access to the web and a direct access to the ISP's content partners (retail vendors) (see page 78, col. 2&3 and fig. 1).

Regarding claim 10, Netsurfer teaches service provider uses desktop application to control what the user sees and when, and provides e-commerce companies space on the desktop application (see page 78). Netsurfer teaches advertising included on a home page (see fig. 1). Netsurfer does not teach the advertising is related the vendor, which the Internet service provider is providing service for. Ziplink teaches the Virtual ISP program being designed to complement an organization's marketing and customer retention efforts (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Netsurfer' desktop which includes advertisement and Ziplink's Virtual ISP program. One would be motivated to include advertising related to the vendor, in order to allow the vendor to provide targeted content to the subscribers. Official notice is taken that is old and well known in the art of Internet service to provide more than two graphical user interfaces for user to access the service. It would have been obvious to one of ordinary skill in the art at the time of the invention to require more than two graphical user interfaces before accessing the vendor site for the purpose of providing the user a first page, log-in page, to allow user login to the service provider's site and a second page, homepage, to allow the user to select a site he/she would like to access.

Regarding claims 11, 16, Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP; providing Internet service through graphical user interface provided by service provider (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded interface can provide user access the web, and direct access to the ISP's content partners i.e., providing an initial interface on behalf of the retailer vendor (see page 76 col. 2 & 3). Netsurfer teach preventing the customer from accessing the Internet services from the service provider.

Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer

teaches using the SoftCast the ISP push content o a user computer and make changes to the

computer and to push software updates, ...and can also fix problems including errors and

software bugs... and update third party software (see 78 and 80). Netsurfer however does not

teach providing Internet services to customer through a service provider, on behalf of retail

vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded

Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations,

etc. to become Virtual ISPs, which implies that customers obtaining Internet service through the

vendor see a graphical interface from the vendor not from Ziplink. Ziplink teaches that the

service includes custom sign-up, activation and authentication, billing and collection, branded

CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the

tremendous investment of building and maintaining a national network and the cost of staffing a

customer care operation center (see page 1). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and

Ziplink's branded Internet service. One would be motivated to provide private-branded Internet

service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing

the connectivity or service and customer care function enables the customers (vendors) to

concentrate on building their business and avoid the tremendous investment of building and

maintaining a national network, as taught by Ziplink (see page 1). Netsurfer teaches controlling

the ability of the customer to add software or hardware. Netsurfer does not teach providing

advertising, to the client based on customer's preferences. Official notice is taken to provide

customized advertising to said client based on preferences received form the client is old and

well known in the art of marketing. One would be motivated to provide advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Regarding claim 21, Netsurfer teaches a processor and a storage coupled to the processor (customer computer), the storage storing instructions that enable the processor to obtain Internet services. Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP i.e., obtaining an initial interface from the service provider on behalf of the retailer vendor (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches when the Signup CD is loaded on user's computer the system posts the data to a server that sets up a user account, to provide Internet service (see page 78 col. 1&2). Netsurfer teaches using branded interface provides the user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3). Netsurfer teach loading the signup CD preventing the customer from accessing the Internet services from the service provider. **Netsurfer teaches controlling the ability of the customer to add software or hardware.** Netsurfer teaches using the SoftCast the ISP push content o a user computer and make changes to the computer and to push software updates, ...and can also fix problems including errors and software bugs... and update thirdparty software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs which implies that customers obtaining Internet service through the vendor see a graphical interface from the vendor not from Ziplink. Ziplink teaches that the service includes custom sign-up, activation and authentication, billing ·

and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system

customers avoid the tremendous investment of building and maintaining a national network and

the cost of staffing a customer care operation center (see page 1). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's

signup platform and Ziplink's branded Internet service. One would be motivated to provide

private-branded Internet service to e-business (retail vendors) that enable them to become Virtual

ISPs since outsourcing the connectivity or service and customer care function enables the

customers (vendors) to concentrate on building their business and avoid the tremendous

investment of building and maintaining a national network, as taught by Ziplink (see page 1).

Netsurfer does not teach receiving, information about preferences and providing advertising to

the client based on preferences received form the client. Official notice is taken to provide

advertising to said client based on preferences received form the client is old and well known in

the art of marketing. One would be motivated to provide customized advertising based on user

preference in order to develop a one-to-one relationship with the user, by providing a targeted

content.

Claims 12 and 22 are rejected as stated above in claim 2.

Claim 13 is rejected as stated above in claim 3.

Claims 14, 23 and 24 are rejected as stated above in claim 4.

Claim 15 is rejected as stated above in claim 5.

Claims 18, 26 are rejected as stated above in claim 8.

Claim 19 is rejected as stated above in claim 9. .

Claim 20 is rejected as stated above in claim 10.

Regarding claim 25, Netsurfer teaches storing instruction that enable the system to control the initial graphical user interfaces from being changed (see page 78 col. 1&2).

Regarding claim 27, Netsurfer teaches user computer, which includes housing and display (see page 78 col. 1).

Regarding claim 36, Netsurfer as modified by Ziplink teaches providing customers (retail vendor) complete ISP options, however does not explicitly teach providing advertising based on another customer's on-line activities. Official Notice is taken that is old and well known in the art at the time of applicant's invention was made to providing suggestion or recommendation on products based on another customer's preference or profile. Web site such as amazon.com provides recommendation to users based on what others purchased before. It would have been obvious to one of ordinary skill in the art to provide such advertising in order to recommend to users what to buy based on similar preference.

Regarding claims 37 and 38, Netsurfer as modified by Ziplink teaches providing customers (retail stores) with Virtual ISP program so customer can receive only those services that best meet their needs, such as dial-up, activation and authentication. Ziplink also teaches branded CD creation therefore, the client using the Virtual ISP will see the vendor site first, during sign-in and like any Internet service provider the vendor would be provide with a graphical user interface for customer to access other sites and to search. Therefore, since the vendor is the ISP, the first thing the customer see, is the vendor site and from the site the customer would be accessing the Internet or searching on the Internet.

Response to Arguments

Applicant's arguments filed may 213, 2005 have been fully considered but they are not persuasive. Applicant argues that the prior art does not teach providing an initial interface on behalf of the retail vendor. Applicant states as explained by the examiner that the customer obtaining Internet services though a vendor first see a graphical interface from the vendor site because the vendor is the ISP. Examiner did not explain such thing. In contrast, the prior art teaches that the service provider (ZipLink) provides a virtual Internet Service Provider program which provided private-branded Internet connectivity and customer care management services that enables them to be virtual ISPs, which implies that ZipLink provides a program which looks like the vendors are the Internet Service Providers not ZipLink. The first thing the customer could see would be the vendor site not ZipLink, otherwise it would not be a virtual ISP.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

/RETTA YEHDEGA
PRIMARY EXAMINER